

Application No.: 10/553,579
Filing Date: April 20, 2006

REMARKS

Claims 1-3, 5-16, and 21-31 were pending in this application prior to entry of the present amendments. Claims 14-16 and 21-31 were withdrawn in the Response to the Restriction Requirement filed on February 13, 2009. Claims 4 and 17-20 were cancelled in a previous action without prejudice. Applicants reserve the right to pursue the subject matter of the cancelled claims at a later date. Claim 1 has been amended by this paper and is supported by at least the non-limiting embodiments described in paragraph [0029] of the originally filed specification. The present amendments do not add new matter.

Oath/Declaration

The Office Action objects to the oath or declaration as being defective. Applicant has submitted a new declaration herewith and respectfully requests that the objection be withdrawn as moot.

Election/Restriction

The Office Action maintains that Claim 1 is drawn to a non-elected invention (“a prosthetic limb”) and Applicant maintains that this objection is improper. The Office Action notes that paragraph [0028] of the Specification “shows that the prosthesis has a joint assembly, a brake and many other sub-devices to make up the prosthesis.” However, notably, Claim 1 still does not claim a prosthetic limb, as restricted. To the contrary, Claim 1 recites a brake assembly, including certain aspects of how it interacts with an arbitrary joint assembly. **Claim 1 does not recite the “many other sub-devices to make up the prosthesis” indicated by the Office Action.** Thus, Claim 1 cannot be drawn to a prosthetic limb for purposes of a restriction, as it does not recite a “prosthetic limb” nor all the subcomponents thereof. Moreover, Applicant notes that the restriction dated 11/13/2008 identified the different inventions as “Group I, claim(s) 1-13 drawn to a brake [, and] Group II, claim(s) 10-20, drawn to a prosthetic limb,” and asserted that “[t]he inventions listed as Groups I and II do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the brake and the prosthetic limb are two different classes.” See Restriction Requirement, page 2. Nowhere does the restriction requirement state that the

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two different inventions are the brake and a prosthetic limb “having a joint assembly.” As discussed above, Applicant has not amended claim 1 to recite a prosthetic limb and therefore maintains that the prior amendment to recite the joint assembly is proper and that the amended claim reads on the elected invention.

Nevertheless, Applicant submits that the amended claims are allowable even without the objected-to limitations. Thus, alternatively, the Examiner could allow the claims without considering these limitations, rendering the issue moot.

Rejection under 35 U.S.C. § 103

The Examiner rejected Claims 1-3 and 5-13 under 35 U.S.C. § 103(a) as being unpatentable over Daniels (US 6,045,076) in view of Chu (U.S. 5,831,417). Applicant respectfully traverses these rejections and the assertions made in the Office Action on what the cited art shows or teaches. Applicant refers to detailed descriptions of these references in Applicant’s previous response.

The Office Action argues that Chu recites “SMAs... which do not change in length when the current is removed.” To support this, the Office Action cites to Col. 5, Lines 34-35 of Chu, which states that “[f]or unchanged drag level, neither of the switches is turned on.” However, this passage does not support the stated conclusion. The paragraph generally gives three options: (1) for increased drag, “turn on” switch 311A, (2) for decreased drag, “turn on” switch 311B, or (3) “[f]or [the] unchanged drag level, neither of the switches is turned on.” “Turning off” the switches is never described. However, the chosen words in the final sentence of the paragraph indicate that turning off the switches would return the mechanism to the “unchanged drag level.” More textually, if one wishes to return to the “unchanged drag level,” one must change the switches such that “neither of the switches is turned on.”

Applicant acknowledges that the cited paragraph of Chu does not clearly support either the interpretation taken by the Office Action or the Applicant. However, Applicant submits that Applicant’s interpretation is more appropriate. For example, it is reasonable to expect the SMA wires 305A, 305B of Chu to act in a manner similar to the SMA wire 305C of Chu. Beginning at Column 5 Line 57, Chu describes applying “short electrical pulses” to create “short and crisp contractions of SMA wire 305C.” Thus, the wire clearly moves back when the current is

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removed. Only when “the periodic short electrical pulses on line 317C [are changed] into a continuous electrical signal” does “SMA wire 305C... contract continuously.” In other words, **a continuous electrical current is necessary to maintain brake operation.** Thus, if SMA wires 305A, 305B are similar to 305C (and Applicant has found no indication in Chu that they are not similar) then they should not meet the relevant claim limitations, and the claims should be allowable over the cited references.

Nevertheless, in order to advance prosecution, Applicant has amended Claim 1 and submits that amended Claim 1 is now allowable over the cited art for additional reasons. For example, Claim 1 now recites a “linear shaft configured to displace longitudinally with respect to the main actuator.” In response to Applicant’s arguments in the previous response, the present Office Action argues that this limitation was not clearly part of the previous claims. Applicant respectfully submits the Office Action’s argument is now moot and that Claim 1 is now allowable over the cited references for at least the reasons described in the previous response, in view of this additional amendment.

Dependent Claims

As Claims 2-3 and 5-13 depend from amended Claim 1 and recite additional distinguishing features, Applicants respectfully submit that Claims 2-3 and 5-13 are likewise allowable over Daniels in view of Chu as each of these claims recites a unique combination of features not taught or suggested by the cited art.

CONCLUSION

Applicants submit that the claims are in condition for allowance and respectfully request the same. Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure,

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including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Furthermore, any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion or that the limitation discussed is essential or critical; rather, patentability must rest on each claim taken as a whole. Applicants respectfully traverse each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although changes to the claims have been made, no acquiescence, disclaimer or estoppel is intended or should be implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or assertion, in the future, of claims relating to the same or similar subject matter. Applicants may not have presented in all cases, arguments concerning whether the applied references can be properly combined or modified in view of the deficiencies noted above, and Applicants reserve the right to later contest whether the cited references can be properly combined or modified.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

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